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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,778	01/22/2002	Bret D. Schlussman	P/4071-3	4257
2352	7590	10/18/2004	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			NGUYEN BA, HOANG VU A	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/053,778

Applicant(s)

SCHLUSSMAN, BRET D.

Examiner

Hoang-Vu A Nguyen-Ba

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the application filed January 22, 2002.
2. Claims 1-21 have been examined.

#### *Priority*

3. The Office acknowledges this application's claim of priority under 35 U.S.C. Section 119(e) based on provisional application U.S. Serial No. 60/314,408, filed on August 23, 2001.

#### *Drawings*

4. The drawings are objected to because of the following minor informalities:
  - a. Figures 1, 2, 3 and 11 are dark and not legible;
  - b. Figures 4, 5, 7 and 8 contain legends with words without delimiters;
  - c. Figure 8 has inadequate margins.Correction is required.

#### *Claim Objection*

5. Claim 16 is objected to because of a possible typographical error that makes claim 16 dependent from 1 instead of 11.  
Appropriate correction is required.

#### *Claim Rejections - 35 USC § 101*

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 11-21 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

Pursuant to these claims, the term “system” is interpreted in light of the specification which indicates that Figure 5 is an example of a first preferred embodiment including a hardware arrangement for developing message interfaces and referred to generally as Message Interface System 10 (page 9, lines 1-3). However, the limitation such as hardware arrangement recited in this portion of the specification cannot be read into the claims. Furthermore, exemplification (i.e., “... Fig. 5 is an example of ...”) is not an explicit definition. Therefore, the term “system” is interpreted to mean a group of interdependent components forming a unified whole, wherein components can be either tangibly or intangibly embodied in a piece of hardware.

According to this broad but reasonable interpretation, claims 11 and 21 merely recite a system comprising a source document, a program evaluator, a source code generation module and a program compiler. These components are merely software components, i.e., computer program *per se*. Such claimed matter, which is descriptive material *per se*, non-functional descriptive material is not statutory because it is not a physical “thing” nor a statutory process as there are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention, which permit the computer’s program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the computer’s functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional

interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus mandatory. *Warmerdam*, 33 F.d at 1361, 31 USPQ 2d at 1760. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106 (IV)(B)(1)(a).

On this basis, claims 11 and 21 are rejected under 35 U.S.C. § 101.

Claims 12-20, which depend from claim 11, are also rejected under 35 U.S.C. § 101 for the same reasons.

### *Claim Rejections – 35 U.S.C. § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-8, 11-18 and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by the admitted prior art (APA) of Figures 3, 4 and pages 1-4 of applicants' background.

### **Claims 1, 11 and 21**

APA discloses a method and system comprising:

*developing a source document in a first language, said source document directing electronic communication with a first computer software application operating on a first computer system* (see at least Figure 4, step S10 and related discussion in applicant's background);

*electronically evaluating said source document to identify keywords, said keywords representing directives in said source document for said electronic communication with said first computer software application (see at least Figure 3 and related discussion in applicant's background);*

*electronically generating program source code in a second language as a function of said step of identifying said keywords in said source document, said source document comprising directives for said electronic communication with first said computer software application (see at least Figure 4, step S14 and related discussion in applicant's background).*

*compiling said source code into object code, said object code functioning as said message interface comprising instructions to format data messages sent by a second computer system to comply with an application program interface corresponding with said first computer software application (see at least Figure 4, step S16 and related discussion in applicant's background).*

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### **Claims 2 and 12**

APA further discloses *directing said message interface to format said data messages prior to a middleware application transmitting said data message to said first computer system (see at least Figure 4, step S12 and related discussion in applicant's background).*

### **Claims 3 and 13**

APA further discloses *directing said message interface to format said data messages after a middleware application transmitting said data message to said first computer system (see at least Figure 4, step S12 and related discussion in applicant's background).*

### **Claims 4 and 14**

APA further discloses *wherein said first computer system is a host system and said second computer system is a client system (see at least pages 1-2 of applicant's background).*

**Claims 5 and 15**

APA further discloses *wherein said first computer system is a client system and said second computer system is a host system* (see at least pages 1-2 of applicant's background).

**Claims 6 and 16**

APA further discloses *wherein said step of electronically generating source code comprises evaluating conditions corresponding with said keywords identified in said source document, and generating said program source code as a function of said evaluated conditions* (see at least Figure 4, steps S12, S14 and related discussion in applicant's background).

**Claims 7 and 17**

APA further discloses *applying a schema to develop said source document, said schema comprising said keywords* (see at least Figure 4, step S10 and related discussion in applicant's background).

**Claims 8 and 18**

APA further discloses *operating a front-end software application used to generate said source document* (see at least page 2, lines 16-19).

***Claim Rejections – 35 USC § 103***

10. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would

have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA as applied to base claims 1, 11 and intervening claims 8, 18, in view of U.S. Patent No. 6,446,081 to Preston.

#### **Claims 9 and 19**

APA does not specifically disclose *wherein said front-end software application prompts a user of said front-end software application with said schema during development of said source document.*

However, Preston teaches an apparatus that parses a source document to locate semantic inconsistencies so a user can correct the errors before the document can be used to act as a specification for the generation of computer code (see at least 2:62 – 3:14). Figures 6a and 6b depict an overview of how a user initiates the operation of data input.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to extend APA teaching with that of Preston because this would provide APA teaching with the capability of detecting errors which would reduce the development time of new message interfaces.

#### **Claims 10 and 20**

APA does not specifically disclose *wherein said front-end software application notifies said user when said source document contains errors.*

However, Preston teaches an apparatus that parses a source document to locate semantic inconsistencies so a user can correct the errors before the document can be



used to act as a specification for the generation of computer code (see at least 2:62 – 3:14).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to extend APA teaching with that of Preston because this would provide APA teaching with the capability of detecting errors which would reduce the development time of new message interfaces.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday, 6:00 to 16:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "Anthony Nguyen Ba".

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**ANTONY NGUYEN-BA**  
**PRIMARY EXAMINER**

Art Unit 2122

October 12, 2004

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